

Application Serial No. 10/718,196

RECEIVED
CENTRAL FAX CENTER

Docket No. 99-88CON1

PATENT

MAR 16 2007

REMARKS

Claims 1-16, 18-21, 26-46, 48, 49 and 53-85 are now pending in the above-referenced patent application. Claims 4-5, 16, 18-21, 33, 46, 48 and 49 are withdrawn based on the election of species requirement. Claims 17, 22-25, 47, 50-52, were previously canceled. Applicants respectfully request further consideration of the pending claims in view of the amendments set forth above and the following remarks.

Amended Claims

Claims 1, 10, 28, 30, 32, 41, 42, 55, 56, 57, 58, 60, 63, 69, 76, 81, 82 and 83 have each been amended to address the objections of form made in the Office action without any intended change in the substantive scope thereof.

No new matter has been added.

Claim Objections

Claims 1, 10, 28, 30, 32, 41, 42, 55, 56, 57, 58, 60, 63, 69, 76, 81, 82 and 83 are objected to due to minor formalities. Specifically, the Examiner has requested that a colon be placed after the term "comprising" and that the numeral "1" be amended to read "one" in the claims. Applicants have made the amendments and request that the objections be withdrawn.

Rejection Under 35 U.S.C. § 112 (Indefiniteness)

Claims 1-3, 6-15, 26-32, 34-35, 53, 54, 56, 57, 60 and 69-85 stand rejected under 35 U.S.C. § 112 as being allegedly indefinite. Applicants respectfully disagree.

Claims 1, 6, 9, 10, 32 and 42 contain alternative limitations to those elected for examination. The Office action has alleged that this makes the claims indefinite and that the limitations be removed.

Applicants submit that the phrases addressed in the Office action, such as "integral with a substrate or with one or more microchip bodies mounted on the substrate" found in claim 1 are alternative limitations that can be described as a Markush group having two alternatives.

A Markush-type claim may include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a

MAR-16-2007 14:16

SYMYX TECHNOLOGIES INC

RECEIVED
CENTRAL FAX CENTER

+1 408 773 4029

P.28

Application Serial No. 10/718,196

Docket No. 99-88CON1
MAR 16 2007

PATENT

prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species prior to examination on the merits. . . . [s]hould no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended.

MPEP 803.02 (emphasis added).

Applicants respectfully submit that since the current Office action has indicated no art that anticipates or renders the elected species obvious, the search should extend to the unelected species. Thus, Applicants submit that it is improper for the Office action to require the cancellation of species from the claims.

For at least this reason, Applicants request that the rejections be withdrawn.

Rejection for Obviousness-Type Double Patenting

Claims 55, 58, 59 and 63-68 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 37, 40, 41 and 43-48 of U.S. Patent 6,701,774. Applicants submit a terminal disclaimer herewith to obviate the rejection. Applicants respectfully request the rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

The Examiner is hereby authorized to charge the fees required in connection with this Amendment A to Deposit Account No. 50-0496, in accordance with the Transmittal submitted herewith. The Examiner is also authorized to debit any other fees required in connection with this application, or to credit any overpayment of fees in connection with this application to Deposit Account No. 50-0496.

MAR-16-2007 14:17

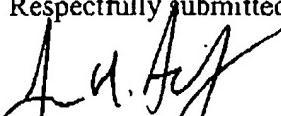
SYMYX TECHNOLOGIES INC

+1 408 773 4029 P.29

Application Serial No. 10/718,196

Docket No. 99-88CON1
PATENT

Respectfully submitted,


James H. Ackley
Reg. No. 45,695
Attorney for Applicant(s)

Date: 3-16-07
Symyx Technologies
415 Oakmead Parkway
Sunnyvale, California 94085
Tel.: (408) 720-2598; Fax: (408) 773-4029